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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,656	06/13/2002	Carsten Woerner	1999/G-020	2826

7590 08/23/2005

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/088,656
Filing Date: June 13, 2002
Appellant(s): WOERNER ET AL.

Ashley Pezzner
For Appellant

MAILED
AUG 23 2005
GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 18, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Grounds of Rejection to be Reviewed upon Appeal*

The following ground(s) of rejection are applicable to the appealed claims:

US 6,489,388

KURZ

12-2002

(8) *Arguments*

Double Patenting Rejection

Claim 1 of the prior art of KURZ discloses a molding composition comprising A) 30-99.8 % by weight of polyoxymethylene homopolymer or copolymer, B) 0.1-10 % by weight of polyalkylene glycol, C) 0.1-10 % by weight of zinc oxide and D) 0-50 % by weight of stabilizers. Claim 6 further narrows down the limitation of component D of the prior art to 0.1-5 % by weight of additive, wherein the additive is a stabilizer. Stabilizer is further defined in the specification of the prior art as polyamides, amides such as dicyandiamide, hydrazines, ureas, lactams and alkaline earth metal salts of acids. Claims of the prior art of KURZ further narrow down the amounts of additional components as required by the present invention.

35U.S.C. 102(e) Rejection

Claim 1 of the prior art of KURZ discloses a molding composition comprising A) 30-99.8 % by weight of polyoxymethylene homopolymer or copolymer, B) 0.1-10 % by weight of polyalkylene glycol, C) 0.1-10 % by weight of zinc oxide and D) 0-50 % by weight of stabilizers. Claim 6 further narrows down the limitation of component D of the prior art to 0.1-5 % by weight of additive, wherein the additive is a stabilizer. Stabilizer is further defined in the

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specification of the prior art as polyamides, amides such as dicyandiamide, hydrazines, ureas, lactams and alkaline earth metal salts of acids. Claims of the prior art of KURZ further narrow down the amounts of additional components as required by the present invention. Polyamides, amides such as dicyandiamide, hydrazines and ureas are clearly envisaged by the prior art of KURZ in the amounts that encompass the requirements of the present invention.

(9) *Response to Argument*

Double Patenting Rejection

Regarding factual details set forth in the rejection, Applicant's primary arguments hinges on the notion that the prior art applied in Double Patenting rejection does not teach the stabilizers of the present invention. As applicants correctly pointed out, claim 6 does indicate that the additive is a stabilizer, however, as applicants further indicated not the nitrogen containing co-stabilizers.

With respect to the nomenclature of stabilizers vs. co-stabilizers, as long as the species of the prior art meet the claim they can be referred to as either one. The fact remains that MPEP 804, "...the specification can always be used as a dictionary to learn the meaning of the term in the patent claims *In re Boylan* 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Furthermore, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42,

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164 USPQ 619, 622 (CCPA 1970). Therefore, the specification of KURZ clearly defines the stabilizer as that required by the present invention (col. 2, line 43-46). As applicants indicated on page 6 of their Appeal Brief, the applicant's claimed invention is a selection invention over KURZ.

35U.S.C. 102(e) Rejection

Regarding factual details set forth in the rejection, Applicant's primary arguments hinges on the notion that the prior art applied cannot form basis for anticipation rejection since there are 10 different groups of additives in the prior art of KURZ and they are optional.

With respect to the above argument, the applicants are again directed to claim 6 of the prior art of KURZ or, col. 2, lines 57-60, both of which clearly indicate that stabilizers are in fact required in amount of 0.1-5 % by weight, preferably 0.5-3 % by weight. Therefore the prior art of KURZ clearly recognized amine containing stabilizers and the amounts of the stabilizers encompass the amount required by the present invention. As further indicated by MPEP 2123.02 "...A REFERENCE THAT CLEARLY NAMES THE CLAIMED SPECIES ANTICIPATES THE CLAIM NO MATTER HOW MANY OTHER SPECIES ARE NAMED..." Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds). The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught...."

Applicants further argued that the examples of the prior art of KURZ do not utilize any stabilizers, let alone applicant's stabilizers.

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When examining the merits of the application, the examiner cannot limit the disclosure of the prior art solely to the examples. The entire teaching of KURZ has to be considered.

Applicants further argued that the prior art of KURZ focuses on resistance against diesel fuel and against gasoline while the present invention focuses on acid resistance.

With respect to the above, applicant's argument is not commensurate with the scope of the independent claims.

The applicants indicated that the prior art of KURZ does not teach melamine as stabilizer, therefore the prior art of KURZ does not anticipate the present invention (claim 16 and 18).

Applicants are correct in sense that KURZ does not teach melamine. However melamine is not a component of the independent claims. The prior art of KURZ therefore applies to the rest of the claims.

With respect to the claim 17, applicants also argued that the rejection does not teach the stabilizers of the present invention not the amounts. As applicants pointed out, claim 6 does indicate that the additive is a stabilizer, however, as applicants further indicated not the nitrogen containing co-stabilizers.

With respect to the nomenclature of stabilizers vs. co-stabilizers, as long as the species of the prior art meet the claim they can be referred to as either one. The fact remains, as discussed above, the specification KURZ not only clearly envisaged the stabilizers of the present invention (col. 2, line 43-46) but also the amounts (col. 2, lines 57-60 or claim 6). As applicants indicated

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on page 6 of their Appeal Brief, the applicant's claimed invention is a selection invention over KURZ. Furthermore, as it was mentioned above "...A REFERENCE THAT CLEARLY NAMES THE CLAIMED SPECIES ANTICIPATES THE CLAIM NO MATTER HOW MANY OTHER SPECIES ARE NAMED..." (see MPEP 2123.02).

The applicants further indicated that claim 24 contains limitation that the molding composition, when in contact with aggressive acid containing cleaning agents, is resistive to said aggressive acids and that the above feature is not disclosed in KURZ who focuses on resistance against diesel fuel or gasoline.

With respect to the above argument, the property of every single chemical compound or component is specific or inherent to that component regardless where or how it is utilized. If the composition of KURZ discloses the particular combination of the components as those disclosed in the present invention, then their properties will flow as inherently, because KURZ teaches every element as claimed at least in independent claims.

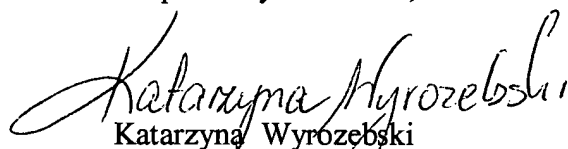
The applicants further noted that claim 27 was not rejected over the prior art of KURZ either in double patenting rejection or anticipation rejection.

With respect to the above argument, claim 27 was added as a new claim in the amendment-after-final. As indicated on the Advisory action dated 2/2/2005 claim 27 is rejected as it claims subject matter of claims 11 and 24 both of which are rejected.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Primary Examiner
Art Unit 1714

kiw

August 16, 2005

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